The test for the same invention is whether the claims being compared could be literally infringed by each other. The court noted that "[a] good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A.).

Claims 1 and 21 of copending Application No. 09/346,375 were amended to clarify that the light energy delivered effects thermal release of the panel from the frame. This clarification is not claimed in the present application. Claims 1 through 10, 13 through 18, 21 through 25, 30 through 34, 38 through 41, 45, and 46 of copending Application No. 09/346,375 would be infringed by thermal release of the panel from the frame as would claims 1 through 7, 10 through 32, and 48 of the present application. Claims 1 through 10, 13 through 18, 21 through 25, 30 through 34, 38 through 41, 45, and 46 of copending Application No. 09/346,375 would not be infringed by a non-thermal release mechanism whereas claims 1 through 7, 10 through 32, and 48 of the present application would be infringed by a non-thermal release mechanism. Based on the amendment and In re Vogel, the claims of the present application could be literally infringed without literally infringing the claims of copending Application No. 09/346,375 and, therefore, the claims do not define identically the same invention. Therefore, it is respectfully submitted that claims 1 through 7, 10 through 32, and 48 are allowable over the provisional rejection under 35 U.S.C. § 101.

Claims 1 through 50 were rejected under 35 U.S.C. § 102(a) as being anticipated by WO(I) (96/17737). Applicants respectfully traverse this rejection.

As to patentability, 35 U.S.C. § 102(a) provides that a person shall be entitled to a patent unless:

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

A rejection grounded on anticipation under 35 U.S.C. § 102 is proper only where the subject matter claimed is identically disclosed or described in a reference. In other words, anticipation requires the presence of a single prior art reference which discloses each and every element of the claimed invention arranged as in the claim. In re Arkley, 455 F.2d 586, 172 U.S.P.Q. 524 (C.C.P.A. 1972); Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481 (Fed. Cir. 1984).

However, under 35 U.S.C. § 363, an international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent Office. As such, the international application enjoys the same effect as of its international filing date as a normal domestic application filed in the United States.

35 U.S.C. § 120 provides that an application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

A rejection based on 35 U.S.C. § 102(a) can be overcome by:

* * *

(E) Perfecting a claim to priority under 35 U.S.C. § 119(a) – (d);

(F) Perfecting priority under 35 U.S.C. § 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application in accordance with 37 C.F.R. 1.78. See M.P.E.P. 706.02(b).

WO 96/17737 to Ledger et al. has a priority date of GB 9424659.2 filed on December 7, 1994 and has a PCT Application No. PCT/GB95/02847 with a filing date of December 6, 1995 in which the United States (U.S.) was a designated state. This PCT application was published on June 12, 1996. This PCT application entered the national phase in the U.S. under 35 U.S.C. § 371 as U.S. Serial No. 08/693,060 and was entitled to the filing date of the PCT application under 35 U.S.C. § 363, which was December 5, 1995.

A continuation application was filed from U.S. Serial No. 08/693,060 and was assigned U.S. Serial No. 09/133,854, filed August 14, 1998.

The present application claims the benefit of 35 U.S.C. § 120 of both prior U.S. Serial Nos. 09/133,854 and 08/693,060. Applicants have previously amended the Specification to contain a specific reference to Serial No. 09/133,854 and Serial No. 08/693,060. The present application and U.S. Serial Nos. 09/133,854 and 08/693,060 are owned by the same assignee. U.S. Serial No. 08/693,060, based on PCT Application No. PCT/GB95/02847 filed on December 6, 1995 under 35 U.S.C. § 363, claimed priority under 35 U.S.C. § 119 to GB 9424659.2 filed on December 7, 1994. As a result, the present application has a priority date prior to June 12, 1996. Therefore, Applicants in the present

application have perfected priority under 119(a) – (d) to overcome the rejection under 35 U.S.C. § 102(a) based on WO 96/17737.

WO 96/17737 is not prior art to the claimed invention of claims 1 through 50. As a result, the claims of the present application cannot be anticipated by WO 96/17737. WO 96/17737 has the same disclosure as copending application Serial No. 09/133,854, which Applicants claim the benefit under 35 U.S.C. § 120 from Serial No. 08/693,060, which is the national stage filing of WO 96/17737. The present application claims the benefit under 35 U.S.C. § 120 of Serial No. 09/133,854. The Specification of the present application was previously amended to contain a specific reference to the earlier filed applications. The present application claims and is entitled to the effective filing date of the common parent application, Serial No. 08/693,060, which is December 5, 1995. This is clearly prior to the international publication date of June 13, 1996. Applicants in the present application have perfected priority under 120 to overcome the rejection under 35 U.S.C. § 102(a) based on WO 96/17737. As such, WO 96/17737 cannot be an anticipatory reference and cannot be 102(a) prior art to claims 1 through 50 of the present application. The rejection is therefore improper and should be withdrawn. Thus, it is respectfully submitted that claims 1 through 50 are allowable over the rejection under 35 U.S.C. § 102(a).

Finally, in relation to independent claims 48 and 49, these claims specify the use of at least one "electric gas discharge tube to produce the light subsequently directed to the bonding material or frit layer". This is clearly not disclosed in WO 96/17737. The Specification of the present application makes clear the benefit of using an electric gas discharge tube for producing the light. A primary benefit is that light energy attenuates rapidly with distance from the apparatus. This has user benefits not present with laser

apparatus. Laser apparatus is the only light delivery apparatus disclosed in WO 96/17737. Therefore, claims 48 and 49 are allowable over the rejection under 35 U.S.C. § 102(a).

Based on the above, it is respectfully submitted that the claims are in a condition for allowance or in a form for appeal. It is respectfully submitted that the claims be reconsidered and the final rejection be withdrawn in light of the above arguments. It is respectfully requested that this Amendment be entered under 37 C.F.R. 1.116.

Respectfully submitted,

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